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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959.

No. 522

SENCO PRODUCTS, INC.,

Petitioner,

vs.

FASTENER CORPORATION AND DUO-FAST CO.,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

STANLEY H. FOSTER,
JOHN W. MELVILLE,
820 Dixie Terminal Building,
Cincinnati 2, Ohio,
Attorneys for Petitioner.

Of Counsel:
WILLIAM J. STELLMAN,
JAMES R. SWEENEY,
20 North Wacker Drive,
Chicago 6, Illinois.

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To the Honorable, the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Senco Products, Inc., prays that a writ of certiorari issue to review the decision and decree of the United States Court of Appeals for the Seventh Circuit which affirmed the decision of the District Court for the Northern District of Illinois, Eastern Division, in the matter of *Senco Products, Inc. v. Fastener Corporation and Duo-Fast Co.*

OPINIONS BELOW.

The opinion of the Court of Appeals for the Seventh Circuit is reported at 269 F. 2d 33.[1]

The opinion of the District Court for the Northern District of Illinois, Eastern Division, is reported at 168 F. Supp. 850 (A. p. 671).[2]

As will be developed further, the same patent here involved was litigated in the sixth circuit. The opinion of the District Court in the sixth circuit is unreported but appears in the record (A. p. 501) and the affirming opinion of the Court of Appeals for the Sixth Circuit is reported at 242 F. 2d 565.[3]

STATEMENT OF JURISDICTION.

The Court of Appeals for the Seventh Circuit delivered its opinion and rendered judgment thereon on July 8, 1959.

A petition for rehearing was denied without further opinion on August 13, 1959.

Jurisdiction is believed conferred on this Court to review the judgment in question by writ of certiorari by the Act of June 25, 1948, 28 U. S. C. 1254, and Rule 19, section 1(b) of this Court because "* * * a court of appeals (the Seventh) has rendered a decision in conflict with the decision of another court of appeals (the Sixth) on the same matter (the validity of patent 2,671,214):". The Petition is timely under 28 U. S. C. 2103(c).

1. Appendix A; further reference to this will be (App. A. p. ....).

2. A. refers to the Joint Appendix used before the Court of Appeals for the Seventh Circuit; this constitutes the record here.

3. Appendix B; further reference to this will be (App. B. p. ....).

THE QUESTIONS PRESENTED FOR REVIEW.

The judgment of the Court of Appeals for the Seventh Circuit, affirming the District Court's holding that United States Letters Patent No. 2,671,214 is invalid, is directly in conflict with the judgment of the Court of Appeals for the Sixth Circuit, affirming the District Court's holding that United States Letters Patent No. 2,671,214 is valid. The specific questions presented, therefore, are:

1. When a District Court uses an incorrect standard of invention and finds a patent invalid, may a Court of Appeals affirm this finding without commenting on such incorrect standard of invention; particularly when this standard has specifically been abrogated *by statute?*

2. When the patent statutes state that a patent is presumed valid, may a Court of Appeals arbitrarily hold that this presumption of validity does not exist as against prior art not "before" the Patent Office, *when the statute makes no such exception* and when it is just as reasonable to conclude that the art not specifically mentioned by the Patent Office was considered by it and cast aside as not pertinent?

3. May a Court of Appeals refuse to consider substantial commercial success as evidence of validity when the patent in suit did not issue until after a hotly contested inter-party contest on the question of patentability was conducted by the Patent Office and another Court of Appeals had found the patent valid?

4. May a Court of Appeals make mis-statements about the teaching and operation of prior art patents and devices and then rely on such mis-statements in holding a patent invalid as lacking invention over such prior art?

THE STATUTES INVOLVED.

The Patent Act of July 19, 1952 (Public Law 593, 82d Cong., 2d sess., ch. 950; 66 Stat. 792), effective January 1, 1953, provides at Title 35, United States Code, section 282 as follows:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

This same Patent Act also provides at Title 35, United States Code, section 103 as follows:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

STATEMENT OF THE CASE.

This is an action for injunction and accounting based on infringement of United States Letters Patent No. 2,671,214, dated March 9, 1954, for Staple Drive Mechanism for Portable Pneumatic Staplers (A. p. 687). Federal jurisdiction in the court of first instance, therefore, was based on the Patent Statutes, 35 U. S. C. sections 271, 281, 283, 284 and 285.

Infringement of the patent is admitted (A. p. 7). Novelty of the invention over the prior art has been established in that both the District Court (A. p. 677) and the Court of Appeals (App. A, p. 19) found the invention to be an "improvement". The primary issue, therefore, is the *patentability* of the invention.

The Invention.

The invention has become widely known in the industry as the "free running driver" invention. It resides in a portable pneumatic stapler which may be grasped much like a large revolver and employed to "fire" a staple into work. A piston, slidable in a cylinder under the influence of air pressure as controlled by pulling a trigger, causes a driver to engage a staple and push it into work whereby to staple same.

In this novel stapler the piston and driver are separate, not rigidly connected together, and there is a definite, separate stop for the piston. The arrangement is such that when the tool is fired the driver and piston accelerate together and move as a unit in the staple driving direction until the piston is stopped by its separate stop, whereafter the driver is free to continue its movement in the staple driving direction, due to its accumulated kinetic energy, to complete the setting of the staple. The driver is stopped by using up its accumulated kinetic energy in setting the staple, or by a stop in the form of a spring, or both. (The spring serves both to return the piston and driver after the gun is fired and as a final limit stop for the stroke of the driver.) In this manner a variable distance of stroke for the driver is provided so that complete setting of the staple is accomplished even though the gun may be brought to the work in a variety of positions. And the actual force applied in setting the staple may be reduced during the driving of the staple by this stopping of the piston separately from the driver.

The reasons why Plaintiff's staplers have been successful in the practical art may be summarized in this way: If the driver were rigidly attached to the piston the on fire driving stroke would be a full power driving stroke. If the driver failed to reach the end of the slide through which